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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re patent application of
Russell E. Parks et al.
Serial No. 09/759,016
Filed January 12, 2001
For SKILLS MATCHING APPLICATION

Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

Group Art Unit 3629
Examiner Jonathan P. Ouellette

APPELLANT'S BRIEF UNDER 37 C.F.R. §1.192

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This brief, which is filed herewith in triplicate, is in furtherance of the Notice of Appeal, filed concurrently herewith.

This brief contains these items under the following headings, and in the order set forth below (37 C.F.R. §1.192(c)):

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DESIRABLE

I. REAL PARTY IN INTEREST

The real party in interest in the appeal is:

- the party named in the caption of this brief.
- the following party: International Business Machines Corp.

New Orchard Road
Armonk, New York 10504

II. RELATED APPEALS AND INTERFERENCES

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal:

- there are no such appeals or interferences.
- these are as follows:

III. STATUS OF CLAIMS

The status of the claims in this application are:

A. Total number of claims in Application

Claims in the application are: Claims 1 to 7.

B. Status of all the claims:

1. Claims cancelled:
2. Claims withdrawn from consideration but not cancelled:
3. Claims pending: Claims 1 to 7.
4. Claims allowed:
5. Claims rejected: Claims 1 to 7.

C. Claims on Appeal.

The claims on appeal are: Claims 1 to 7

IV. STATUS OF AMENDMENTS

The status of amendments filed subsequent to the final rejection are as follows: No amendments have been filed subsequent to the final rejection; however, the final rejection states on page 1 that it is in response to the amendment filed on February 12, 2003, whereas there was a second, supplemental amendment filed by facsimile on March 31, 2003. This second amendment was in direct response to the Examiner's suggested amendments to claims 1 and 4 made during a telephone interview on March 26, 2003. It is noted that the Examiner in paragraph 16 on page 6 of the final rejection acknowledges "arguments filed 1/28/03 and 3/31/03", so it is assumed for purposes of this appeal that the second, supplemental amendment filed on March 31, 2003, has been entered in the application. It is noted, however, that no arguments were filed on January 28, 2003, and it can only be assumed that the Examiner meant to reference the arguments in the amendment filed on February 12, 2003. These assumptions were confirmed by telephone conference with the Examiner, Mr. Jonathan P. Ouelette, on May 13, 2003.

V. SUMMARY OF INVENTION

The invention as defined in the claims on appeal is directed to a tool that allows a user, such as a hiring manager, to communicate requirements to technical service suppliers in a way that significantly reduces the process time and improves the accuracy of requests sent to suppliers. While methods have been developed to procure components and hardware in manufacturing many products, including for example automobiles and computers, the procurement of services, and especially technical services, has not received the same attention. The process, prior to the claimed invention, was still a matter of advertising, using third party employment services and other intermediaries. The invention provides a way to timely respond to a specific, immediate although temporary need for technical services.

The present invention provides a tool that allows a user, such as a hiring manager, to communicate requirements to technical service suppliers in a way that significantly reduces the process time and improves the accuracy of requests sent to suppliers. This is done with a Skills Matching Application (SMA), the architecture of which is shown in Figure 1. The SMA is accessed from a Requisition/Catalog (REQ/CAT) application 101, which may be either a Web-based application or a standalone application. A user who needs to request a technical contractor accesses the REQ/CAT application (or goes directly to the SMA Universal Resource Locator (URL)) which brings the user to the SMA Web site (see page 5, lines 11–14). The SMA application, after requiring a password and profile (for first time access) to be entered, takes the user through a series of screens which prompts the user to enter a Statement of Work (SOW) and complete a skills detail checklist for each of the technical skills requested. As set out on page 5, line 18, to page 6, line 5, some of the information required to be entered are the following:

- a) type and skill required, i.e., programmer, network specialist, database administrator, etc.;

- b) level of the skill;
- c) proficiency level of specific operating systems, programming languages and tools required of the candidate;
- d) work location, on-call, weekend work, experience required for position, etc.;
- e) other related SOW information; and
- f) file attachments can also be included.

Once the request is completed, it is submitted to contracted suppliers (individual contracted suppliers versus all contracted suppliers can be identified by the requestor) who are sent an e-mail notification via the SMA Internet site 103. This SMA external Internet site 103 is accessed by the suppliers when they receive the e-mail notification. The notification notifies the supplier that a new request has been entered into the SMA application for them to review and submit a candidate against. This e-mail has a standard formatted attachment which contains the statement of work and skills detail checklist. The SMA application has the capability to identify suppliers as primary, secondary, and so on for a skill and send the request immediately to the primary and, after a first predetermined number of days, to the secondary and, after a second predetermined number of days, to the next and so on (page 6, lines 17-20). The requestor can cancel the request, and the SMA tool sends an e-mail to all suppliers who were sent the request. e-mail notifications are sent to suppliers when the requestor performs any action against the request and *vice versa*.

The suppliers, when they receive an e-mail request, access the Web site database to view the request details. Suppliers can also use the e-mail notifications and attachments to load into their local systems. Each supplier has the option of accessing the SMA Web site or generating and transmitting a batch interface to SMA to submit candidates and appending resumes as appropriate. The supplier provides a response to the SOW by responding to the entries with the candidate's skills, experience, etc. The supplier enters the candidate's name and wage (if different from

the agreed to rate for that region or skill).

The requestor will receive an e-mail notification each time the supplier submits a candidate. The requestor then accesses the SMA Web site and views the supplier responses and associated resumes and can either accept or reject each candidate submitted but cannot accept more than the number of candidates requested. Once the requester accepts the candidate(s), the request is considered closed and the request is archived after the next SMA batch process is complete. The requestor then submits the candidate(s) to the REQ/CAT Web site where it is assigned to a requisition. The requester then completes the requisition (i.e., adding travel and other related expenses, etc.) and then moves through the requisition approval process. When the SMA is used as a standalone application, the requestor uses the tool to source the contractor requirement and then would go to the requisition system to complete the transaction (page 6, line 26, to page 7, line 5).

Once the requisition is approved in the REQ/CAT Web site 104, it is sent on to the SAP procurement system 105 (which is a third party software application) for conversion to a purchase order and transmission to a supplier. SAP is the system that completes the requisition process and transmits the Purchase Order (PO) to the supplier for billing and payment. Status changes, i.e., submitted, pending, sent to REQ/CAT, and Approved (in REQ/CAT Web site), and purchase order (PO) number from the SAP procurement system are reflected in the status field on the SMA database.

In addition, the SMA application supports a Renewal, Known Candidate and "Submit Requisition Directly to REQ/CAT Web" process. The renewal process is used to "renew" a technical subcontractor who is already working for the company. Known items are the candidate(s) name(s) and supplier. These requests are only sent to the supplier who is already providing the candidate(s). The Known Candidate function is used to send a request to a supplier for a candidate that has already been

identified. The "Submit Requisition Directly to REQ/CAT Web" process is used when the requestor knows the candidate(s) name(s), the supplier and the rate to be charged. These requests are not sent to suppliers; rather, the request when completed is sent directly to the REQ/CAT Web site.

The linkage with the REQ/CAT Web application and the supplier is shown in more detail in Figure 2. The requester (client) accesses the REQ/CAT Web 201 and invokes the REQ/CAT Web application at 202 to create a requisition. This process invokes the Skills Matching Application (SMA) 220 which prompts the requester to enter requirements or SOW at function block 221. A determination is made in decision block 222 as to whether this is new request or renewal with a core supplier. If so, the requester is prompted to select suppliers in function block 223. The requester is next prompted to submit requirements (or SOW) in block 224. This information is then passed to the supplier via the Internet after e-mail notification. In function block 250, the supplier reviews the requirements (or SOW). A response is made in function block 251. The supplier attaches the resume(s) and submits candidate(s) in function block 252 with the response. The requester views the candidates submitted and selects candidate(s) in function block 225. A request to create a requisition is submitted by the requestor in function block 226, and this request is exported to the REQ/CAT Web application. The REQ/CAT Web application imports candidate and pricing in function block 203, and enters approval routing in function block 204. The request is submitted for approval in function block 205. A submitted request is processed for approval in function block 206. Once approved, the request is submitted to the SAP procurement system in function block 207. (See page 7, line 13, to page 8, line 6.)

VI. ISSUES

The issues presented on appeal are:

- (1) whether the claimed invention lacks patentable utility under 35 U.S.C. §101;
- (2) whether, under the assumption that the claimed invention lacks patentable utility, one skilled in the art would not know how to use the claimed invention under 35 U.S.C. §112, first paragraph; and
- (3) whether the claimed invention is anticipated by U.S. Patent No. 6,289,340 to Puram et al. under 35 U.S.C. §102(e).

Since the second issue is predicated on the first and both are based on the Examiner's position that the claimed invention lacks patentable utility, the issues are really one grounded on two different sections of the Patent Statute; therefore, the two issues for purposes of this appeal will be treated together as but a single issue.

VII. GROUPING OF CLAIMS

Group 1 includes claims 1 to 4, drawn to a Skills Matching Application (SMA) which allows a user to communicate requirements to technical service providers. As originally presented, these claims were written as process claims; however, by supplemental amendment filed by facsimile on March 31, 2003, these claims were amended to add the language "means for" preceding each of the process steps. The amendments to these claims were made at the suggestion of the Examiner, Mr. Jonathan P. Ouellette in a telephone interview with the undersigned, Mr. Whitham, and one of the inventors, Mr. Russell E. Parks, on March 26, 2003.

Group 2 includes claims 5 to 7, drawn to a computer system running the Skills Matching Application.

The claims do not stand or fall together. Reasons as to why the grouped claims are separately patentable are included in the arguments.

ARGUMENT VIIIA. REJECTIONS UNDER 35 U.S.C. §101 AND §112, FIRST PARAGRAPH

Claims 1 to 7 were rejected under 35 U.S.C. §101 as lacking patentable utility. In making this rejection, the Examiner states the following:

“In Claims 1-7, the ambiguities cited would make it impossible for the process to be repeatable or ‘concrete’. In other words, different users would come up with different responses.”

Claims 1 to 7 were additionally rejected under 35 U.S.C. §112, first paragraph, for the reason, according to the Examiner, that “since the claimed invention lacks patentable utility, . . . one skilled in the art clearly would not know how to use the claimed invention.” The two grounds of rejection are both based on the Examiner’s position that the claimed invention lacks utility and, therefore, the two grounds of rejection are treated together.

Attached to this Brief is the Declaration Under 37 C.F.R. §132 of Russell E. Parks, one of the inventors named in this application, which Declaration was filed with the first amendment on February 12, 2003. Mr. Parks provides data in numbered paragraph 4 of his declaration which demonstratively shows the commercial success of the claimed invention which, in turn, is a clear indication of the utility of the invention. As Mr. Parks notes in his declaration, since different individuals have different skill sets and different requesters have different skill needs, one would expect different users to come up with different responses. However, this should not be taken as an indication that the process is not repeatable or concrete.

The invention is described in full and complete terms so as to enable one skilled in the computer and data processing arts to make and use the invention. First of all, there is provided a Skills Matching Application (SMA), the overall architecture of which is shown in Figure 1. This SMA application is accessed from a Requisition/Catalog (REQ/CAT) application, which may be either a Web-based application or a standalone application. A user who needs to request a technical

contractor accesses the REQ/CAT application (or goes directly to the SMA Universal Resource Locator (URL)) which brings the user to the SMA Web site.

The SMA application takes the user through a series of screens which prompts the user (shown as the "client" in Figure 2) to enter a Statement of Work (SOW), block 221 in Figure 2, and complete a skills detail checklist for each of the technical skills requested. Some of the information required to be entered are the following:

- a) type and skill required, i.e., programmer, network specialist, database administrator, etc.;
- b) level of the skill;
- c) proficiency level of specific operating systems, programming languages and tools required of the candidate;
- d) work location, on-call, weekend work, experience required for position, etc.;
- e) other related SOW information; and
- f) file attachments can also be included.

Once the request is completed, it is submitted, blocks 223 and 224 in Figure 2, to contracted suppliers who are sent an e-mail notification. The e-mail communication is illustrated in Figure 1. This e-mail notification notifies the supplier that a new request has been entered into the SMA application for them to review and submit a candidate against. This e-mail has a standard formatted attachment which contains the statement of work and skills detail checklist.

The SMA application has the capability to identify suppliers as primary, secondary, and so on for a skill and send the request immediately to the primary and, after a first predetermined number of days, to the secondary and, after a second predetermined number of days, to the next and so on.

The suppliers, when they receive an e-mail request, access the Web site database to view the request details, block 250 in Figure 2. Suppliers can also use the e-mail notifications and attachments to load into their local systems. The supplier

provides a response to the SOW by responding to the entries with the candidate's skills, experience, etc. See blocks 251 and 252 in Figure 2.

The requestor (or "client" as shown in Figure 2) will receive an e-mail notification each time the supplier submits a candidate. The requestor then accesses the SMA Web site and views the supplier responses and associated resumes and can either accept or reject each candidate submitted but cannot accept more than the number of candidates requested. See blocks 203 and 204 in Figure 2. Once the requester accepts the candidate(s), the request is considered closed and the request is archived after the next SMA batch process is complete. The requestor then submits the candidate(s) to the REQ/CAT Web site where it is assigned to a requisition, block 205 in Figure 2. The requester then completes the requisition (i.e., adding travel and other related expenses, etc.) and then moves through the requisition approval process, block 206 in Figure 2.

Once the requisition is approved in the REQ/CAT Web site, block 206 in Figure 2, it is sent on to SAP procurement system, block 207 in Figure 2, for conversion to a purchase order and transmission to a supplier. Status changes, i.e., submitted, pending, sent to REQ/CAT, and Approved (in REQ/CAT Web site), and purchase order (PO) number from SAP are reflected in the status field on the SMA database.

In addition to the process defined here, the SMA application supports a Renewal, Known Candidate and "Submit Requisition Directly to REQ/CAT Web" process. The renewal process is used to "renew" a technical subcontractor who is already working for the company. Known items are the candidate(s) name(s) and supplier. These requests are only sent to the supplier who is already providing the candidate(s). The Known Candidate function is used to send a request to a supplier for a candidate that has already been identified. The "Submit Requisition Directly to REQ/CAT Web" process is used when the requestor knows the candidate(s) name(s),

the supplier and the rate to be charged. These requests are not sent to suppliers; rather, the request when completed is sent directly to the REQ/CAT Web site.

From the foregoing and the attached declaration under 37 C.F.R. §1.132 of Russell E. Parks, it is clear that the disclosed and claimed invention satisfies the utility requirement of 35 U.S.C. §101 and, moreover, that one skilled in the art would know how to use the invention as required under 35 U.S.C. §112, first paragraph. Therefore, it is respectfully requested that the rejections based on 35 U.S.C. §§101 and 112, first paragraph, be reversed.

ARGUMENT VIIIB. REJECTIONS UNDER 35 U.S.C. §112, SECOND PARAGRAPH

There are no rejections under 35 U.S.C. §112, second paragraph.

ARGUMENT VIIIC. REJECTIONS UNDER 35 U.S.C. §102

Claims 1 to 7 were also rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,289,340 B1 to Puram et al. This rejection is respectfully traversed for the reason that Puram et al. neither show nor suggest the claimed invention.

Puram et al. discloses a consultant matching system and method for selecting candidates from a candidate pool to fill a position. The system generates and stores profiles of candidates based on skills and experience, generates and stored a skills profile for a position to be filled, adjusts the skills profile of candidates based on levels of skills needed, and compares candidates based on their adjusted profiles.

Puram et al. contemplate a system which provides three different user interfaces – one for candidates, one for employers and one for experts which provide third-party evaluations of the candidates. Using the user interface for candidates 52 in Figure 1c, a candidate enters his or her technical skills and skill level for each skill. A candidate also enters his or her industry experience, skill levels for communication and leadership skills, and project experience. See Figure 2. An expert using the user interface for third-party evaluations 51, generates and enters a third part assessment based on an interview with the candidate. The data from the two user interfaces 52 and 51 are communicated through the Internet 60 to a Web server 55 where it is received by a data receiving and interrogating process 67 to acquire an adjust candidate profile that is stored in database 65. An employer, using the employer user interface 53, inputs via the Internet a request to the Web server 55. This request includes skills selected by the employer from a list of pre-defined skills. The data receiving and interrogating process 68 accesses the database 65, and a matching and ranking process 69 compares candidates based on adjusted profiles and returns the ranked candidates to the employer.

Reference is again made to the attached Declaration Under 37 C.F.R. §1.132

of Russell E. Parks. Mr. Parks discusses the Puram et al. patent in numbered paragraph 5 of his declaration. Mr. Parks notes there that what Puram et al. describe is known in the art as a “Monster Board” where technical service providers enter data about their skills and users of these skills enter requirements and the system attempts to make a match. This is quite unlike the claimed invention where suppliers respond to a Request for Service (RFS) by submitting candidates to the requester. Puram et al. includes a database of perspective candidates, whereas the claimed invention includes no such database.

Claim 1 recites “*A Skills Matching Application (SMA) which allows a user to communicate requirements to technical service suppliers*” (emphasis added). The process implemented by the SMA includes:

“*means for accessing the SMA from a Requisition/Catalog (REQ/CAT) application;*

“*means for prompting a user through a series of screens to enter a Statement of Work (SOW) and complete a skills detail checklist for each of the technical skills requested;*

“*means for submitting the request to contracted suppliers by e-mail notification* notifying the supplier that a new request has been entered into the SMA application for them to review and submit a candidate against;

“*means for receiving from a supplier a candidate or candidates with appended resumes as appropriate; and*

“*means for displaying for the user the supplier responses and associated resumes*” (emphasis added).

Note that the suppliers are contracted suppliers who are notified by e-mail. Mr. Parks states in his declaration under 37 C.F.R. §1.132 that the claimed invention is a proprietary systems; that is, the suppliers of the services have contracts with the user of the system which specify pre-negotiated rates for the services that may be

requested. Note also that it is the supplier of the services that submits to the requester candidate(s) with appended resume(s). No database is maintained by the claimed invention.

Independent claim 4 contains similar limitations. Specifically, claim 4 recites "*A Web-based Skills Matching Application (SMA) which allows a user to communicate requirements to technical service suppliers*" (emphasis added). The process implemented by the SMA includes:

"means for accessing the SMA from a Web-based Requisition/Catalog (REQ/CAT) Web application;

"means for selecting by a user who needs to request a technical contractor a SMA Web site;

"means for prompting the user through a series of screens in the SMA Web site to enter a Statement of Work (SOW) and complete a skills detail checklist for each of the technical skills requested;

"means for submitting the request to contracted suppliers who are sent an e-mail notification notifying the supplier that a new request has been entered into the SMA application for them to review and submit a candidate against;

"means for accessing the SMA Web site database by a supplier to view the request details;

"means for providing by a supplier a candidate or candidates by accessing the SMA Web site and submitting candidates and appending resumes as appropriate; and

means for viewing by the user the supplier responses and associated resumes and either accepting or rejecting each candidate submitted" (emphasis added).

Again, note that the suppliers are contracted suppliers who are notified by e-mail. No database is maintained as in the Puram et al. system. The Skills Matching Application receives supplier responses and associated resumes of candidates.

While claims 1 to 4 are directed to the process performed by the Skills Matching Application, claims 5 to 7 are directed to a computer system running the Skills Matching Application. Note again that claims 1 to 4 were amended by the Supplemental Amendment filed by facsimile on March 31, 2003, to add the phrase "means for" before each process step in the originally filed claims 1 to 4. This came about as a result of a telephone interview on March 26, 2003, initiated by the Examiner, Mr. Jonathan P. Ouellette. An Interview Summary is attached to the final rejection. In that Interview Summary, the Examiner acknowledges discussing claims 1, 4 and 5 and makes the statement "Mr. Whitham, Mr. Parks, and Examiner Ouellette discussed different possible ways of narrowing the independent claims to increase chances of patentability suchs [sic] as: detailing the Skills Matching system and method for dealing with contracted suppliers." Mr. Whitham and Mr. Parks have a different recollection of that telephone interview, as recorded in the "Remarks" section of the Supplemental Amendment filed on March 31, 2003. In particular, the paragraph bridging pages 4 and 5 of the Supplemental Amendment states the following:

"Based on Mr. Parks' description, Mr. Ouellette suggested that certain ones of the claims be amended to more clearly tie the claimed invention to the invention as disclosed in the specification. In particular, Mr. Ouellette suggested that claim 1 be amended to be a system claim reciting the process steps in "means plus function" form. This supplemental amendment amends claim 1 as suggested by Mr. Ouellette. In addition, dependent claim 3 has been amended to reflect the amendment to claim 1. Claim 4 has also been amended similarly to claim 1."

No amendments were suggested for claim 5. Upon Mr. Ouellette's suggestion for the amendment to claim 1 and a similar amendment to claim 4, Mr. Whitham first asked

Mr. Parks if he had any objection to such an amendment and, when Mr. Parks said he had none, Mr. Whitham then asked Mr. Ouellette whether that would place the application in condition for allowance. It is the clear recollection of both Mr. Whitham and Mr. Parks that Mr. Ouellette indicated in the affirmative. Had he not done so, the Supplemental Amendment would not have been filed.

Despite the amendments to claims 1 and 4, claims 1 to 4 remain essentially process claims as distinguished from the apparatus claims 5 to 7. Independent claim 5 recites “*A computer system running Skills Matching Application (SMA)* which allows a user to communicate requirements to technical service suppliers” (emphasis added). This computer system comprises:

“means for accessing the SMA from a Requisition/Catalog (REQ/CAT) application also running on the computer system;

“a display system for prompting a user through a series of screens to enter a Statement of Work (SOW) and complete a skills detail checklist for each of the technical skills requested;

“transmitting means for submitting the request to contracted suppliers by e-mail notification notifying the supplier that a new request has been entered into the SMA application for them to review and submit a candidate against; and

“receiving means for receiving from a supplier a candidate or candidates with appended resumes as appropriate, said display system displaying for the user the supplier responses and associated resumes” (emphasis added).

Thus, claim 5 is directed to the computer system that runs the Skills Matching Application and, in addition, a Requisition/Catalog Application. This computer system includes means for transmitting a submitted request to contracted suppliers by e-mail notification. The computer system also includes means for receiving from a supplier candidate(s) with appended resume(s).

From the foregoing, it is clear that Puram et al. do not anticipate the claimed

invention under 35 U.S.C. §102(e). Therefore, it is respectfully requested that the rejection under 35 U.S.C. §102(e) be reversed.

ARGUMENT VIIID. REJECTIONS UNDER 35 U.S.C. §103

There are no rejections under 35 U.S.C. §103; however, as demonstrated by the arguments presented with respect to U.S. Patent No. 6,289,340 to Purnam et al., the claimed invention is not taught, suggested or otherwise made obvious in view of the reference relied on by the Examiner. Therefore, the Appellants are entitled to a patent on their claimed invention.

More specifically, the Purnam et al. system requires the establishment and maintenance of a database, and no such database is required by the disclosed and claimed invention. The claimed invention contemplates working with contracted suppliers and notification to those suppliers by e-mail. In contrast, Purnam et al. contemplates three interfaces – one for candidates, one for employers, and one for experts which provide third-party evaluations of the candidates – a completely different approach to the claimed invention.

ARGUMENT VIII.E. REJECTION OTHER THAN 35 U.S.C. §§102, 103 AND 112

There are no rejections other than the rejections under 35 U.S.C. §§102 and 112.

IX. APPENDIX OF CLAIMS INVOLVED IN THE APPEAL (37 C.F.R. §1.192(c)(9))

The text of the claims involved in the appeal are:

1 1. A Skills Matching Application (SMA) which allows a user to communicate
2 requirements to technical service suppliers in a way that significantly reduces
3 the process time and improves the accuracy of requests sent to suppliers
4 comprising:

5 means for accessing the SMA from a Requisition/Catalog (REQ/CAT)
6 application;

7 means for prompting a user through a series of screens to enter a
8 Statement of Work (SOW) and complete a skills detail checklist for each of
9 the technical skills requested;

10 / / means for submitting the request to contracted suppliers by e-mail
11 notification notifying the supplier that a new request has been entered into the
12 SMA application for them to review and submit a candidate against; *server*

13 / / means for receiving from a supplier a candidate or candidates with
14 appended resumes as appropriate; and

15 / means for displaying for the user the supplier responses and associated
16 resumes.

1 2. The Skills Matching Application of claim 1, wherein the SMA and
2 REQ/CAT applications are Web-based and an SMA Web site is provided for
3 suppliers to access to view request details and submit a candidate or
4 candidates.

1 3. The Skills Matching Application of claim 1, further comprising means for
2 responding to a user's selection of a candidate or candidates by invoking an

- 3 approval and procurement process.
- 1 4. A Web-based Skills Matching Application (SMA) which allows a user to
2 communicate requirements to technical service suppliers in a way that
3 significantly reduces the process time and improves the accuracy of requests
4 sent to suppliers comprising:
5 means for accessing the SMA from a Web-based Requisition/Catalog
6 (REQ/CAT) Web application;
7 means for selecting by a user who needs to request a technical
8 contractor a SMA Web site;
9 means for prompting the user through a series of screens in the SMA
10 Web site to enter a Statement of Work (SOW) and complete a skills detail
11 checklist for each of the technical skills requested;
12 means for submitting the request to contracted suppliers who are sent
13 an e-mail notification notifying the supplier that a new request has been
14 entered into the SMA application for them to review and submit a candidate
15 against;
16 means for accessing the SMA Web site database by a supplier to view
17 the request details;
18 means for providing by a supplier a candidate or candidates by
19 accessing the SMA Web site and submitting candidates and appending
20 resumes as appropriate; and
21 means for viewing by the user the supplier responses and associated
22 resumes and either accepting or rejecting each candidate submitted.
1 5. A computer system running Skills Matching Application (SMA) which
2 allows a user to communicate requirements to technical service suppliers in a

3 way that significantly reduces the process time and improves the accuracy of
4 requests sent to suppliers comprising:

5 means for accessing the SMA from a Requisition/Catalog (REQ/CAT)
6 application also running on the computer system;

7 a display system for prompting a user through a series of screens to
8 enter a Statement of Work (SOW) and complete a skills detail checklist for
9 each of the technical skills requested;

10 transmitting means for submitting the request to contracted suppliers
11 by e-mail notification notifying the supplier that a new request has been
12 entered into the SMA application for them to review and submit a candidate
13 against; and

14 receiving means for receiving from a supplier a candidate or
15 candidates with appended resumes as appropriate, said display system
16 displaying for the user the supplier responses and associated resumes.

1 6. The computer system of claim 5, wherein the SMA and REQ/CAT
2 applications are Web-based and an SMA Web site running on the computer
3 system is provided for suppliers to access to view request details and submit a
4 candidate or candidates.

1 7. The computer system of claim 5, further comprising means for responding
2 to a user's selection of a candidate or candidates by invoking an approval and
3 procurement process running on said computer system.

X. OTHER MATERIALS THAT APPELLANT CONSIDERS NECESSARY OR
DESIRABLE

Other materials that Appellants consider necessary and desirable for consideration by the Board of Patent Appeals and Interferences is the Declaration Under 37 C.F.R. §1.132 of Russell E. Parks filed February 12, 2003, a copy of which is attached.

Respectfully submitted,



C. Lamont Whitham
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of

Russell E. Parks et al.

Serial No. 09/759,016

Group Art Unit 3629

Filed January 12, 2001

Examiner Jonathan P. Ouellette

For SKILLS MATCHING APPLICATION

Assistant Commissioner for Patents
Washington, D.C. 20231

DECLARATION OF RUSSELL E. PARKS
UNDER 37 C.F.R. §1.132

Russell E. Parks declares as follows:

1. I am one of the named inventors in the above-identified patent application.
2. Briefly described, the invention disclosed therein relates to a Skills Matching Application or SMA application or tool. The SMA application is a tool that allows a user, such as a hiring manager, to communicate requirements to technical service suppliers in a way that significantly reduces the process time and improves the accuracy of requests sent to suppliers. While methods have been developed to procure components and hardware in manufacturing many products, including for example automobiles and computers, the procurement of services, and especially technical services, has not received the same attention. Prior to the present invention, the process was still a matter of advertising, using third party employment services and other intermediaries. The SMA application provides a way to timely respond to a specific, immediate although temporary need for technical services.

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3. I have read and understand the Office Action mailed November 25, 2002. The Examiner has rejected claims 1 to 7, all the claims in the patent application, under 35 U.S.C. §101 and 35 U.S.C. §112, first paragraph, as lacking utility and, therefore, not being usable by one of ordinary skill in the art. In addition, the Examiner has rejected claims 1 to 7 under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 6,289,340 B1 to Puram et al.

4. As to the rejections of the claims under 35 U.S.C. §101 and 35 U.S.C. §112, first paragraph, as lacking utility, the Examiner is in error. The SMA application has experienced significant increase in usage within the IBM Corporation in the past three years. The following table shows the increase in activity

	Activity 1999/2000	Activity 2002	Comments
Requests Created	First Half 2000 – 78 requests	Full year 2002 – 23651 requests	
Handsfree Requests Created	Full Year 2000 – 1940 requests	Full Year 2002 – 9876 Requests	These are requests that go through the entire process without buyer intervention
User IDs Created	Full Year 2000 – 500	Full Year 2002 – 4505	
Dollars through system	Half year 2000 – Approx. \$5M	Full Year 2002 – \$1.76B	

The Skills Matching Application was modified in 2002 to accommodate the buying of other service commodities within the IBM Corporation. The Complimentary Workforce Commodity and the Business Services Commodity were added to the SMA tool now making the SMA application the single means to purchase all services in the IBM Corporation. Quite clearly, the SMA application has demonstrated considerable commercial success which, in turn, is a demonstrative indicator of the utility of the invention.

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In making his rejection, the Examiner stated that "In Claims 1-7, the ambiguities cited would make it impossible for the process to be repeatable or 'concrete'. In other words, different users would come up with different responses." In response, since different individuals have different skill sets and different requesters have different skill needs, one would expect different users to come up with different responses. Moreover, this should not be taken as an indication that the process is not repeatable or concrete.

The SMA tool is designed to buy services versus products. The response to each request will be the resume of a different person. But by design, the Job Descriptions within the SMA application for that skill type are defined to describe very specific Type of Skills. For example, we have a Skill Type "Programmer" which is supported by a specific job description. Then within that "Programmer" job description, there are several levels of expertise. When a requester needs to hire a "Programmer", the requester selects the specific job description, then defines the customizable attributes of that programmer. A good analogy is buying a car. You go shopping for a Ford Mustang Convertible, then you customize the color, engine, etc. The process is very much repeatable as you are limited to buying the Skill Types defined to the SMA application.

5. I have read and understand the Puram et al. reference relied on by the Examiner and I have reviewed the several other references cited by the Examiner. I note first of all that the many references cited by the Examiner, including the Puram et al. reference, seem to demonstrate rather conclusively that the claimed invention has utility under the Patent Statute. Considering the cited prior art, the SAM application of the claimed invention differs from all other applications of this type in that it supports the end-to-end process of buying services. Considering the Puram et al. reference specifically, the reference describes what is known in the art as a "Monster Board" where technical services providers enter data about their skills and users of these skills enter requirements and the system attempts to make a match. Skills matching as claimed in this patent application differs in that first it

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is a proprietary system. IBM Corporation has core suppliers of services that are allowed to receive requirements from the SMA tool. The SMA tool has pre-negotiated cap rates and job skills defined to the system. The suppliers are responding to the Request for Service (RFS), and in most cases supply that service at or below the negotiated price. If a supplier responds above a negotiated rate, the SMA tool notifies the IBM buyers of the service. The SMA tool then creates a means for the requester and supplier to interact on the RFS. When a candidate is finally chosen, the SMA application creates the appropriate data transaction to create an IBM Purchase Requisition within the IBM Requisition Tool Request Category. This process is facilitated in that the SMA tool will designate the rate as a BUYERLESS transaction and, once management and financial approvals are provided, the Purchase Order is transmitted.

In contrast, Puram et al. is a system that includes a database of perspective candidates. The candidate information is entered into the system, and then a requester enters their requirements and the application does a comparison of candidate attributes to requirements. I would also assume that the Puram et al. application is for not only temporary, but more likely permanent placement of the technical resource. The SMA tool is not a database and is strictly a procurement tool for the acquisition of temporary resources. It is a communication tool to a predefined list of IBM Technical Services suppliers. The suppliers review the IBM requirements based on a pre-approved IBM job description. The pricing, T&Cs, quality level and other IBM conditions are assumed when you are allowed to access the SMA application. Suppliers then respond to the requirement with candidate(s). Selection is then by the IBM requester. Once a candidate is selected, the SMA tool closes the purchasing loop and creates a Purchase Requisition.

6. I have reviewed each of the other references cited by the Examiner; however, none of them appear to be pertinent to the claimed invention for the SMA application. I note that sheet number and nature of the references cited by the Examiner seem to contradict his first rejections on the ground of lack of utility.
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7. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date:

2/11/03Russell E. Parks

Russell E. Parks